REMARKS

Applicants hereby traverse the current rejections, and request reconsideration and withdrawal of the rejections in light of the remarks contained herein. Claims 9, 18, 28, and 29 have been canceled without prejudice. Claims 30-32 were not rejected and Applicants request an indication of their allowability. Claims 1-8, 9-17, 19-27, and 30-32 are pending in this application.

Double Patenting

Claims 1, 15, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13, and 24, respectively of U.S. Patent No. 6,725,317. Applicants propose filing a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) or otherwise addressing this rejection, if the rejection still stands upon an indication of allowability of the claims over the prior art of record.

Prior Art Disqualification Under 35 U.S.C. 103(c)

The Office Action uses Diesing et al. (US No. 6,701,360, hereinafter Diesing) as a prior art reference to make a 103(a) rejection.

35 U.S.C. 103(c) states "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Diesing is a 102(e) prior art reference, in that the application is a continuation of an earlier U.S. application, the effective filing date is the same as the earliest filing date in the line of continuation, specifically, April 29, 2000, and the filing date of Diesing is April 13, 2000. The instant application and Diesing are both subject to assignment to Hewlett-Packard Company. Thus, Diesing is disqualified as prior art under 35 U.S.C. 103(c).

Claims 9-10, 18, and 28-29

Claims 9-10, 18, and 28-29 have been canceled without prejudice in order to further prosecution.

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However, regarding claim 9, the Office Action admits that Okazawa or Kleinsorge do not specifically disclose that the service processor can be replaced while the system is on-line. The Office Action then attempts to cure this deficiency stating "one skilled in the art would have known to have the service processor [sic] to replace while the system is online to replace the faulty [sic] of service processor." Applicants note however that the Examiner has only alleged that the invention is within the capabilities of one of ordinary skill in the art, providing no motivation, and as per MPEP 2143.01 section IV, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness (MPEP 2143.01 section IV). Thus, the subject matter of claim 9 would be allowable over the prior art of record. However, to advance prosecution of this application, Applicants have canceled claim 9.

Regarding claim 18, Diesing is relied upon to teach elements of claim 18, but as discussed above, Diesing is disqualified as prior art under 35 U.S.C. 103(c). Thus, the subject matter of claim 18 would be allowable over the prior art of record. However, to advance prosecution of this application, Applicants have canceled claim 18.

The Office Action cites Okazawa, column 6, lines 23-35, as teaching the limitations of claim 28. However, Applicants note that Okazawa's processor boards 11 do not exclude other processor boards 11 from being part of its partition after a reset. Kleinsorge is not relied upon for these limitations. Thus, the subject matter of claim 28 would be allowable over the prior art of record. However, to advance prosecution of this application, Applicants have canceled claim 28.

Claim 29 depends from claim 28, and thus inherits all the limitations of claim 28. Thus, claim 29 sets forth features and limitations not recited by Okazawa in view of Kleinsorge. Thus, the subject matter of claim 29 would be allowable over the prior art of record. However, to advance prosecution of this application, Applicants have canceled claim 29.

Rejections under 35 U.S.C. § 103

Claims 1-3, 5-8, 11, 13-17, 19-22, 24, and 26-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Okazawa et al. ('021, hereinafter Okazawa) in view of Kleinsorge et al. ('734, hereinafter Kleinsorge).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

Lack of Limitations

The Office Action admits that Okazawa does not teach having the service processor and each cell board maintain a copy of the data that describes the configuration for the computer system. The Office Action attempts to cure this deficiency by introducing Kleinsorge, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a computer system wherein "the service processor and each cell board stores a copy of the data" that describes the configuration for the computer system. The Office Action admits that Okazawa does not teach such a limitation. The Office Action relies on Kleinsorge only for teaching that "each cell board maintains a copy of the data". See the Office Action, page 5. Thus, the rejection fails to address the service processor storing a copy of the data that describes the configuration for the computer system. The Office Action is silent as to a source for teaching having the service processor store a copy of the data that describes the configuration for the computer system. Therefore, the combination of Okazawa and Kleinsorge does not teach all of the limitations of claim 1.

Further, Applicants note that Kleinsorge teaches initialized partitions having a primary CPU and uninitialized partitions having "no primary CPU executing either under

control of a console program or an operating system" (see col. 7 line 62 to col. 8 line 19).
Additionally, Kleinsorge teaches the console program, running on a primary CPU of a
partition, stores the configuration data. Thus, as boards 100, 102, 104, and 106 that are
assigned to an uninitialized partition do not have a primary CPU nor run the console program,
the boards do not store configuration data. Therefore, Kleinsorge does not teach a system
wherein "the service processor and each cell board stores a copy of the data.," as recited by
claim 1. Therefore, the Applicants respectfully assert that for at least the above reasons claim
1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 15 defines a method that comprises "storing a copy of the data [that describes
an initial configuration for the computer system] in the service processor and in each cell
board." The Office Action admits that Okazawa does not teach such a limitation. The Office
Action relies on Kleinsorge only for teaching that "each cell board maintains a copy of the
data". See the Office Action, page 5. Thus, in the combination of references, the rejection
fails to teach storing a copy of the data in the service processor. The Office Action is silent
as to a source for teaching the claimed storing. Thus, the combination of Okazawa and
Kleinsorge does not teach all of the claimed limitations, as stated by the Office Action.

Further, Applicants note that Kleinsorge teaches every initialized partition having a
primary CPU and uninitialized partitions having "no primary CPU executing either under
control of a console program or an operating system" (see col. 7 line 62 to col. 8 line 19).
Further, Kleinsorge teaches the console program running on a primary CPU of a partition that
stores the configuration data. Thus, as boards 100, 102, 104, and 106 that are assigned to an
uninitialized partition do not have a primary CPU nor run the console program, the boards do
not store configuration data. As a result, Kleinsorge does not teach a method comprising
"storing a copy of configuration data in the service processor and in each cell board," as
recited by claim 15. Therefore, the Applicants respectfully assert that for at least the above
reasons claim 15 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 27 defines a computer system wherein "the service processor and each cell
board stores a copy of data that describes a configuration for the computer system." The
Office Action admits that Okazawa does not teach such a limitation. The Office Action relies

on Kleinsorge only for teaching that "each cell board maintains a copy of the data". See the Office Action, page 5. Thus, in the combination of references, the rejection fails to teach having the service processor store a copy of the data that describes the configuration for the computer system. The Office Action is silent as to a source for teaching a service processor that stores a copy of the data that describes the configuration for the computer system. Thus, the combination of Okazawa and Kleinsorge does not teach all of the limitations of claim 27, as stated by the Office Action.

Further, Applicants note that Kleinsorge teaches every initialized partition having a primary CPU and uninitialized partitions having "no primary CPU executing either under control of a console program or an operating system" (see col. 7 line 62 to col. 8 line 19). Further, Kleinsorge teaches the console program running on a primary CPU of a partition that stores the configuration data. Thus, as boards 100, 102, 104, and 106 that are assigned to an uninitialized partition do not have a primary CPU nor run the console program, these boards do not store configuration data. As a result, Kleinsorge does not teach a system wherein "the service processor and each cell board stores a copy of data that describes a configuration for the computer system," as recited by claim 27. Therefore, the Applicants respectfully assert that for at least the above reasons claim 27 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-3, 5-8, 11, 13, and 14 depend from independent claim 1 and claims 16-17, 19-22, 24, and 26 depend from independent claim 15. Thereby, each of claims 2-3, 5-8, 11, 13, 14, 16, 17, 19-22, 24, and 26 inherit all limitations of their respective base claim, claim 1 or claim 15. Therefore, for at least the reasons advanced above in addressing the rejections of independent claims 1 and 15, each of claims 2-3, 5-8, 11, 13-14, 16-17, 19-22, 24, and 26 sets forth features and limitations not recited by the combination of Okazawa and Kleinsorge. Therefore, Applicants respectfully assert that claims 2-3, 5-8, 11, 13, 14, 16, 17, 19-22, 24, and 26 are also patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 4 is rejected over Okazawa in view of Kleinsorge further in view of Diesing. Claim 4 depends from base claim 1, and thus inherits all limitations of claim 1. Claim 1 is defined as described above. Okazawa in view of Kleinsorge does not disclose limitations of

claim 1 as discussed above. Diesing is disqualified as a prior art reference under 35 U.S.C.

103(c), as discussed above, and may not be relied upon to disclose these limitations. Thus,

claims 4 sets forth features and limitations not recited by Okazawa in view of Kleinsorge, as

discussed above. Thus, the Applicant respectfully asserts that for the above reasons claim 4

is patentable over the 35 U.S.C. § 103(a) rejection of record.

Lack of Motivation

The Office Action admits that Okazawa does not teach having the service processor

and each cell board maintain a copy of the data that describes the configuration for the

computer system. The Office Action attempts to cure this deficiency by introducing

Kleinsorge, which the Office Action alleges to teach having such elements. The motivation

for making the combination was presented as follows:

> "It would have obvious ... to have combined the teachings of
> Kleinsorge et al. into the teachings of Okazawa et al. because it
> would [sic] a flexible computer system having maximum
> resource availability and scalability."

It is well settled that the proposed modification cannot change the principle operation

of a reference, M.P.E.P. § 2143.01. Okazawa discloses having an active partition and a

standby partition, such that when a fault occurs the system replaces the active partition with

the standby partition. Thus, in Okazawa, only one partition is running at any moment.

Kleinsorge is a multiple partition system, with more than one partition operating at a given

moment. Since Okazawa and Kleinsorge each operate on different principles, the suggested

combination of references would require a substantial reconstruction and redesign of the

elements of Okazawa, as well as a change in the basic principle under which the system of

Okazawa was designed to operate. The M.P.E.P. clearly states that such substitution is

impermissible, see M.P.E.P. § 2143.01.

In the Office Action dated September 20, 2005, at page 8, the Examiner states "the

fact that applicant has recognized another advantage which would flow naturally from

following the suggestion of the prior art cannot be the basis for patentability when the

differences would otherwise be obvious." As discussed above, Applicants assert that there is

25597537.1

11

no motivation to make the combination presented by the Examiner. Okazawa and Kleinsorge operate on different principles and substantial reconstruction and redesign would be required to make the claimed combination, such that the claimed combination does not naturally flow from following the suggestion of the prior art. Thus, there is not motivation to make the claimed combination.

It is also well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The motivation provided to include the teaching of Kleinsorge with system of Okazawa is insufficient for the modification being proposed. Okazawa already has a system that is flexible and has maximum resource availability. Okazawa discloses having an active partition and a standby partition, such that when a fault occurs the system replaces the active partition with the standby partition. Thus, the system of Okazawa is capable of operations after incurring a fault. Thus, the system is flexible and has resource availability. Okazawa is also scaleable in that a partition may be expanded, see column 11, line 36 and Figure 16. Thus, the language of the motivation statement merely indicates that the Okazawa can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

In the Office Action dated September 20, 2005, at page 8, the Examiner states "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." As discussed above, Applicants assert that there is no motivation to make the combination presented by the Examiner, in that the references already have features addressing the Examiner's cited motivation and as such, the Examiner has not properly established the desirability for the combination.

25597537.1

12

No valid suggestion has been made as to why a combination of Okazawa and Kleinsorge is desirable. Therefore, the rejection of claims 1-3, 5-8, 11, 13-17, 19-22, 24, and 26-28 should be withdrawn.

Conclusion

Previously presented claims 30-32 were not rejected nor indicated as pending by the Office Action. Claims 30, 31, and 32 depend from base claims 1, 15, and 27, respectively, and thus inherit all limitations of their respective base claims. Claims 30-32 set forth features and limitations not recited by the prior art of record. Thus, the Applicants respectfully assert that claims 30-32 should be indicated as being allowable over the prior art of record.

For all the reasons given above, the Applicants submit that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103. Accordingly, the Applicants submit that this application is in full condition for allowance.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10001728-3 from which the undersigned is authorized to draw.
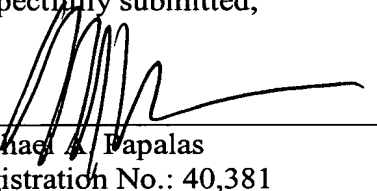
Dated: November 30, 2005

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482724865US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: November 30, 2005

Signature: Phyllis Ewing

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13